

**REMARKS**

**A. Allowable Subject Matter**

Applicant wishes to thank the Examiner for indicating that claims 11, 24, 32 and 39 are allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

**B. Double Patenting**

Claims 1, 4, 12, 15, 28 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 16, 28 and 35 of U.S. Patent No. 6,865,179 (the '179 Patent) in view of U.S. Patent No. 6,330,239 to Suzuki ("Suzuki").

Without admitting or denying the substance of these rejections, the Applicants have submitted a terminal disclaimer (see Attachment A). Accordingly, by filing this terminal disclaimer the Applicants believe that the non-statutory, double-patenting rejections are now moot.

Accordingly, Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1, 4, 12, 15, 28 and 33.

Accordingly, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1, 4, 12, 15, 28 and 33.

**C. The Section 103 Rejections Based On Chang '412 In Combination With Other References.**

Claims 1 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,920,412 to Chang ("Chang '412") in view of

U.S. Patent No. 6,657,757 to Chang et al ("Chang '757"). Further, claims 2, 3, 7, 13, 14, 28 and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chang '412 in view of Chang '757, and further in view of U.S. Patent No. 5,570,355 to Dail et. al. ("Dail"). Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Applicant respectfully submits that Chang '412 fails to teach or suggest: (i) the routing of IP traffic based on an ATM service category; (ii) at least one circuit switch and packet switch fabric making up a (iii) hybrid telecommunications switch as recited in claim 1 and similarly recited in claims 12, 28 and 33.

As admitted by the Examiner, Chang '412 is unrelated to IP traffic. Further, Applicant respectfully submits that the "type check 24" disclosed in Chang '412 determines whether an optical signal is an ATM or STM signal without taking into consideration the *ATM service level* of any of the traffic (see Chang '412, column 12, lines 13-14; 32-33; 53-54; and column 15, lines 25-52). In sum, Chang '412 does not disclose the routing of IP traffic based on an ATM service category as recited in claim 1 and similarly recited in claims 12, 28 and 33.

Next, though the Examiner appears to equate the "Optical Network Routing Apparatus (ONRA) 14d" of Chang '412 with the claimed hybrid telecommunications switch, this is inaccurate. The ONRA is a router, not a

switch. Chang '412 itself uses the two words router and switch differently (see for example, "ONRA 14d", "ATM switch 10", and "STM Station or Switch 20" in Fig. 4.). In sum, Chang '412 does not disclose a hybrid telecommunications switch as recited in claim 1 and similarly recited in claims 12, 28 and 33.

Last, but not least, the Examiner appears to equate the "STM" and "ATM" add/drop multiplexers (ADMs) 28, 32 of Chang '412 with the claimed circuit switch and packet switch fabrics. This too is inaccurate. An ADM is not a switch as is no doubt realized by the Examiner. Further, Chang '412 itself uses the two words ADM and switch differently (see for example, "STM ADM 28", "ATM ADM 32", "ATM switch 10", and "STM Station or Switch 20" in Fig. 4.). In sum, Chang '412 does not disclose a hybrid telecommunications switch that comprises a circuit switch fabric and packet switch fabric as recited in claim 1 and similarly recited in claims 12, 28 and 33.

Applicants respectfully submit that neither Chang '757 nor Dail makes up for these deficiencies.

The Office Action also includes rejections of other claims of the instant application under 35 U.S.C. 103(a) based on a combination of Chang '412, Chang '757 with one or more additional references, some of which have been relied upon by the Examiner (and traversed by the Applicant) in previous Office Actions.

Applicants respectfully submit that each of these other rejected claims are dependent upon either claim 1, 12, 28 or 33 and are, therefore, patentable over a combination of Chang '412, Chang '757 and any other additional reference(s) for the reasons set forth above with respect to claims 1, 12, 28 and 33 and because none of these additional references makes up for the deficiencies of Chang '412.

**D. Conclusion**

Applicant respectfully requests withdrawal of the rejections and allowance of claims 1-42.

In the event this Response does not place the present application in condition for allowance, applicant requests the Examiner to contact the undersigned at (703) 266-3330 to schedule a personal interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC

By: \_\_\_\_\_

John E. Curtin, Reg. No. 37,602  
P.O. Box 1995  
Vienna, Virginia 22183  
(703) 266-3330